



Asian Domain Name Dispute Resolution Centre

hong kong

(Hong Kong Office)

ADMINISTRATIVE PANEL DECISION

| | |
|---------------------------------|--------------------------|
| Case No. | HK-2401871 |
| Complainant: | Xiaomi Inc |
| Respondent: | Pasti Sukses |
| Disputed Domain Name(s): | xiaomi-france.com |

1. The Parties and Contested Domain Name

The Complainant is **Xiaomi Inc** of No.006, Floor 6, Building 6, Yard 33, Middle Xierqi Road, Haidian District, Beijing, China.

The Respondent is **Pasti Sukses** of Komplek Cemara Asri Jalan Makmur No. 88Q, Medan, Sumatera Utara 20371, ID.

The domain name at issue is **xiaomi-france.com** registered by Respondent with GoDaddy.com, LLC of 14455 North Hayden Rd, Suite 219, Scottsdale AZ 85260, United States
Tel: + 1 480 505 8800
Email: udrpdisputes@godaddy.com.

2. Procedural History

The Complaint was received by the Asian Domain Name Dispute Resolution Centre (ADNDRC) (Hong Kong Office) on 1 February 2024. The Complainant has elected to have the Complaint decided by one Panellist.

The Complaint was sent by the ADNDRC to the Respondent on 23 February 2024 and the deadline for the Respondent to submit a Response to the Complaint was 14 March 2024. No Response was received from the Respondent by the deadline.

This dispute is governed by the Uniform Policy for Domain Name Dispute Resolution. (the ICANN Policy), the Rules for Uniform Domain Name Dispute Resolution Policy (the ICANN Rules) and the ADNDRC Supplemental Rules.

3. Factual background

The Complainant is the owner of a number of “XIAOMI” trademark registrations across various jurisdictions. The trademarks relevant to this instant matter are:

| TRADEMARK | JURISDICTION/ TM OFFICE | REGISTRATION NUMBER | REGISTRATION DATE | IC CLASS |
|---------------|----------------------------|------------------------|----------------------|----------------|
| XIAOMI | EU / EUIPO | 017972921 | Apr. 18, 2019 | 18, 21, 25, 37 |
| XIAOMI | EU / EUIPO | 018107686 | Jan. 25, 2020 | 8, 24 |
| XIAOMI | WO / WIPO | 1177611 | Nov. 28, 2012 | 9, 35, 38, 42 |
| XIAOMI | WO / WIPO | 1474970 | Mar. 14, 2019 | 6, 10 |
| XIAOMI | US / USPTO | 4527605 | May 13, 2014 | 9, 35, 38, 42 |
| XIAOMI | US / USPTO | 6077119 | Jun. 16, 2020 | 6, 10 |

The Complainant was founded in April 2010 and listed on the Main Board of the Hong Kong Stock Exchange on 9 July 2018 (1810.HK). The Complainant is a consumer electronics and smart manufacturing company with smartphones and smart hardware connected by an Internet of Things platform at its core. In these 13 years, the Complainant has grown to become one of the leading providers of innovative technology worldwide.

The Complainant’s range of products includes phones, smart home devices including vacuums or kitchen appliances, and lifestyle goods such as smart watches or electric scooters. The Complainant’s strength is reflected in #3 global market share ranking in smartphone with a global user base exceeding 594 million and an estimated 618 million IoT connected devices. In the first quarter of Fiscal Year 2023, Complainant achieved a revenue of RMB 59.5 billion and an adjusted net profit of RMB 3.2 billion.

The Complainant maintains a strong internet presence, communicating with its large customer base and promoting its inventive products through its website and social media profiles. Complainant’s main website is located at its primary domain name, <mi.com>, which it gained control of on 21 April 2014. SimilarWeb has ranked it the 1,204th most popular website globally, and the 90th in China, with an estimated 36.2 million individual visitors in May 2023 alone. The Complainant has 15 million Facebook followers and likes; 4.4 million Twitter followers; and 4.6 million Instagram followers.

Complainant has also made significant investment to advertise and promote the XIAOMI and MI trademarks worldwide in media and the internet over the years.

The Respondent is the current registrant of the Disputed Domain Name. As the Respondent did not file a Response to the Complaint, no further information on the Respondent is available.

4. Parties' Contentions

A. The Complainant contentions may be summarized as follows:

- i) The disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights:

The Complainant is the owner of XIAOMI trademarks as set out above.

The Complainant claims that in creating the Disputed Domain Name, the Respondent has added the generic, geographical term "France" to the Complainant's XIAOMI trademark, thereby making the Disputed Domain Name confusingly similar to Complainant's trademark. The fact that such term is closely linked and associated with Complainant's brand and trademark only serves to underscore and increase the confusing similarity between the Disputed Domain Name and the Complainant's trademark. More specifically: "France" – where Complainant has business presence and is widely known. The Respondent's addition of a hyphen does nothing to distinguish the Disputed Domain Name from the Complainant's trademarks. The use of such hyphen does not diminish the confusing similarity between the Disputed Domain Name and Complainant's trademarks and should be disregarded for purposes of making this determination.

In addition, the Respondent's use of the Disputed Domain Name contributes to the confusion. The Respondent is using the Disputed Domain Name for the sale of Xiaomi products, which suggests that Respondent intended the Disputed Domain Name to be confusingly similar to the Complainant's trademark as a means of furthering consumer confusion. Further the Respondent's use of the Disputed Domain Name to direct to a website selling the Complainant's products is further evidence that the Disputed Domain Name is confusingly similar to the Complainant's trademark.

- ii) The Respondent has no rights or legitimate interests in respect of the domain name(s):

The Complainant claims the granting of registrations by the EUIPO, WIPO, and the USPTO to the Complainant for the XIAOMI trademarks is *prima facie* evidence of the validity of the term "XIAOMI" as a trademark, of the Complainant's ownership of the trademark, and of the Complainant's exclusive right to use the XIAOMI trademarks in commerce on or in connection with the goods and/or services.

The Respondent is not sponsored by or affiliated with the Complainant in any way. Furthermore, the Complainant has not given Respondent consent or license to use Complainant's trademarks in any manner, including in domain names.

The Respondent is not commonly known by the Disputed Domain Name, which evinces a lack of rights or legitimate interests.

Further, the Complainant claims the Disputed Domain Name is redirecting internet users to a website that copies and attempts to duplicate Complainant's official website by copying the design, color scheme, pictures, and/or text found on the Complainant's website. As such,

the Disputed Domain Name's website has purposely been designed to serve as a replica of Complainant's website, all as a means of deceiving internet users into believing that the Disputed Domain Name and its website are associated with Complainant. The Respondent's attempt to pass off the Disputed Domain Name as being affiliated with the Complainant, and in fact as being the Complainant, is in itself evidence of the fact that Respondent does not have rights and legitimate interests in the Disputed Domain Names

The Complainant also claims that Disputed Domain Name's website is currently redirecting internet users to a number of third party websites that sell the Complainant's competitors products and also to websites featuring gambling content. As such, the Respondent is not using the Disputed Domain Name to provide a bona fide offering of goods or services as allowed, nor a legitimate non-commercial or fair use as allowed under Policy.

Also, the Respondent registered the Disputed Domain Name on 7 November 2013, which is after Complainant's registration of its XIAOMI trademarks with the EUIPO, WIPO and USPTO, and also after the Complainant's registration of its <xiaomi.com> domain name on 13 September 1998.

iii) The disputed domain name has been registered and is being used in bad faith:

The Complainant and its XIAOMI trademarks are known internationally, with trademark registrations across numerous countries. The Complainant has marketed and sold its goods and services using this trademark before Respondent's registration of the Disputed Domain Name.

The Complainant claims that at the time of registration of the Disputed Domain Name, the Respondent knew, or at least should have known, of the existence of the Complainant's trademarks and that registration of domain names containing well-known trademarks constitutes bad faith per se. In addition to the numerous trademarks filed in connection with Complainant's business prior to Respondent's registration of the Disputed Domain Name, the Complainant is ranked 132nd in Fortune Global 500 World's Biggest Companies 2021 ranking and 45th in Fortune's ranking of the Top 50 Companies with the best long term growth potential in 2020. According to Fortune, the Complainant is also ranked amongst the World's Most Admirable Companies in 2021, which demonstrates the Complainant's fame. Further, performing searches across a number of internet search engines for "xiaomi france" returns multiple links referencing Complainant and its business.

The Complainant claims the use of the Disputed Domain Name constitutes a disruption of the Complainant's business as it is confusingly similar to the Complainant's trademark. The Disputed Domain Name can only be taken as intending to cause confusion among internet users as to the source of the Disputed Domain Name, and thus, the Disputed Domain Name must be considered as having been registered and used in bad faith, with no good faith use possible. More specifically, where the Disputed Domain Name comprises of Complainant's XIAOMI trademark and its related term 'France' where the Complainant is based and widely known, there is no plausible good-faith reason or logic for Respondent to have registered the Disputed Domain Name.

The Complainant also claims that the presence of a disclaimer on the Disputed Domain Name's website makes it abundantly clear that Respondent knew of Complainant when registering and using the Disputed Domain Name, and that Respondent selected the domain to intentionally confuse unsuspecting internet users into visiting its website. The Respondent appears to have acknowledged the likelihood of confusion with Complainant by voluntarily placing a disclaimer on the website. The conduct of the Respondent suggest that the registration was in bad faith.

B. Response to the Complaint.

There was no Response filed by the Respondent.

5. Findings

Notwithstanding that no Response to the Complaint was received, the Complainant is still required to satisfy the conditions set out under the ICANN Policy and Rules in order to prevail in its Complaint.

The ICANN Policy provides, at Paragraph 4(a), that each of the three elements must be established in order for the Complainant to receive a decision in its favour:

- i. Respondent's domain name is identical or confusingly similar to a trademark or service mark in which Complainant has rights; and
- ii. Respondent has no rights or legitimate interests in respect of the domain name; and
- iii. Respondent's domain name has been registered and is being used in bad faith.

In determining whether Paragraph 4(a)(iii) has been satisfied, the evidence should satisfy any one limb of Paragraph 4(b).

The Panel's findings as follows:

i) Identical / Confusingly Similar

The Complainant is the registerer proprietor of the XIAOMI trademark in a number of countries around the world.

The Disputed Domain Name comprises word XIAOMI which is the Complainant's corporate name and trademark and the hyphenated geographic term "France". Disregarding the TLD as well as any generic or geographic term, the disputed Domain Name is identical to the Complainant's trade mark.¹

¹ *WIPO Jurisprudential Overview 3.0* at 1.8 "Where the relevant trademark is recognizable within the disputed domain name, the addition of other terms (whether descriptive, geographical, pejorative, meaningless, or otherwise) would not prevent a finding of confusing similarity under the first element.

The Panel also accepts the Complainant's contention that the use of the Disputed Domain Name has caused or is likely to cause confusion to internet users and customers of the Complainant and that the Disputed Domain Name is confusingly similar to the Complainant's XIAOMI trademark.

This Panel finds that the Disputed Domain Name is identical or confusingly similar to the Complainant's trademark. As such paragraph 4(a) (i) of the ICANN Policy is satisfied.

ii) Rights and Legitimate Interests

The Complainant registered the trademarks "XIAOMI" as early as 28 Nov 2012. The Complainant's domain name "xiaomi.com" was registered on 13 Sept 1998. The Disputed Domain Name was registered on 7 November 2013. There is no evidence of any earlier use of the mark "XIAOMI" by the Respondent. It is abundantly clear that the Complainant has prior trademark rights in the trademark "XIAOMI" over the Respondent. No consent or licence has been granted by the Complainant to the Respondent for the use of the trademark XIAOMI and the Respondent is not connected nor affiliated with the Complainant in any way. Also, the Respondent is not commonly known by the Disputed Domain Name.

Furthermore, the Disputed Domain Names is being used to redirect users to other third party websites, selling products in competition with the Complainant. In the absence of any evidence to the contrary, the Panel accepts the Complainant's contention that the Disputed Domain Name's website has purposely been designed to serve as a replica of Complainant's website, all as a means of deceiving internet users into believing that the Disputed Domain Name and its website are associated with Complainant.

As such the Panel finds that the Respondent has no rights or legitimate interests in respect of the domain name.² Paragraph 4(a) (ii) of the ICANN Policy is satisfied.

iii) Bad Faith

The Complainant is a global consumer electronic and smartphone company. It has the third highest global market share of smartphones. The Complainant's global user base exceeds 594 million with an estimated 618 million IoT connected devices. The Complainant is ranked 132nd in Fortune Global 500 World's Biggest Companies 2021 and 45th in Fortune's ranking to top 50 companies best long term growth potential in 2020. Furthermore, when performing searches on a number of internet search engines for "xiaomi france", there are multiple links referencing the Complaint and its businesses.

The Panel accepts the Complainant's contention that the Respondent must have known of the Complainant's prior trademark rights and that the Disputed Domain Name was registered to

² In the absence of any license or permission from the Complainant to use its trademark, no actual or contemplated bona fide or legitimate use of the Disputed Domain Name could reasonably be claimed." See *Sportswear Company S.P.A. v. Tang Hong*, D2014-1875 (WIPO Dec. 10, 2014).

disrupt the Complainant's business and to cause confusion.³ The presence of a disclaimer on the Disputed Domain Name website, undoubtedly shows that the Respondent was well aware of the Complainant, its business and websites. The Respondent attempts to attract, for commercial gain, internet users to its web site or other on-line location, by creating a likelihood of confusion with the Complainant's trademark and name, is further evidence that the registration of the Disputed Domain Name is being used in bad faith.⁴

Furthermore, the Disputed Domain Name website is being used to direct users to third party gambling websites.⁵ This is further evidence that the Respondent has no legitimate interests in and that the Disputed Domain Name is being used in bad faith. The Panel notes that the Respondent has failed to file a Response to the Complaint which also suggests that the Respondent has no legitimate rights in, or is not interested in protecting the Disputed Domain Name.

Accordingly, the Panel finds that, based paragraph 4(b)(iii) and (iv) of the ICANN Policy, the registration of the Disputed Domain Name was registered and is being used in bad faith. As such paragraph 4 (a)(iii) of the ICANN Policy is satisfied.

6. Decision

Before any order to direct the transfer of the domain name can be made, all three elements of Paragraph 4(a) of the Policy must be established by the Complainant. Based on the Policy, the Complaint and the above analysis, this Panel finds all 3 elements in Paragraph 4 (a) have been met. As such, the registration of the Disputed Domain Name was made in bad faith.

The Panel therefore directs that the Disputed Domain Name, <xiaomi-france.com>, be transferred from the Respondent to the Complainant.

DocuSigned by:

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Alban Kang
Sole Panellist

Dated: 3 April 2024

³ *Philipp Plein v. Domain Admin, Whois Privacy Corp.*, D2016-1519 (WIPO Sept. 12, 2016) (Respondent acted in bad faith by registering the disputed domain name to disrupt the Complainant's relationship with their customers or potential customers and/or to attempt to attract Internet users for commercial gain. Respondent purported to sell Philipp Plein products, without Complainant's authorization, from the website to which the disputed domain name resolves.).

⁴ *WIPO Jurisprudential Overview 3.0 at 3.7* ("Where the overall circumstances of a case point to the respondent's bad faith, the mere existence of a disclaimer cannot cure such bad faith. In such cases, panels may consider the respondent's use of a disclaimer as an admission by the respondent that users may be confused.")

⁵ *WIPO Jurisdictional Overview 3.0 at 2.5.3* ("A respondent's use of a complainant's mark to redirect users (e.g., to a competing site) would not support a claim to rights or legitimate interests")